

REMARKS

Claims 1, 2, 4, 5 and 8 – 22 are pending in the application, and have been rejected. Claim 1 has been objected to.

Claim Objections:

Claim 1 was objected to because of an informality. Applicants have amended Claim 1 to address this objection, and respectfully request that the objection now be withdrawn.

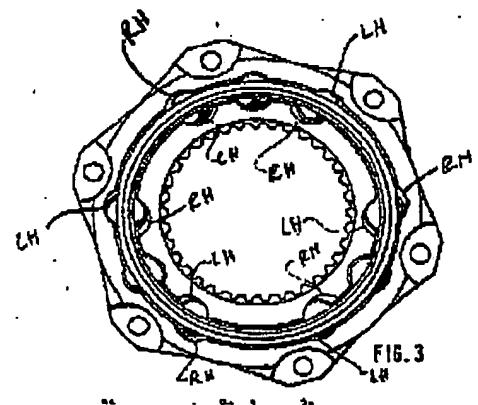
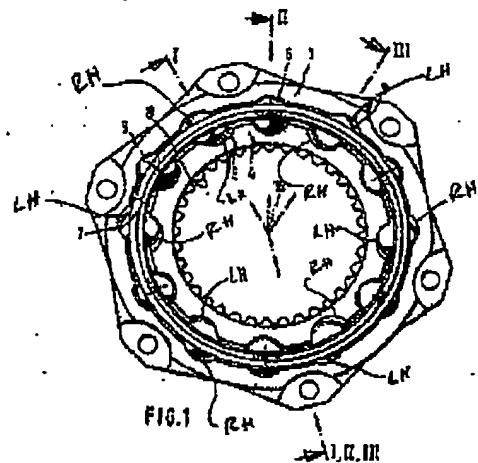
Claim Rejections Under § 102(b):

Claims 1, 2, 4, 5, 8, 10, 21 and 22 have been rejected under § 102(b) as being anticipated by US Pat. No. 4,678,453 (Aucktor et al.). Applicants respectfully traverse these rejections, submit that the rejections are improper, and request that they be withdrawn.

"It is to be noted that . . . rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in 'the prior art.'" Application of Arkley, 455 F.2d 586, 587 (C.C.P.A. 1972) (emphasis in original). Aucktor et al. '453 does not identically disclose or describe the claimed subject matter.

Independent Claim 1 calls for an inner joint member having a longitudinal axis centered with respect thereto and an outer surface defining a plurality of radially outwardly facing substantially helical grooves including at least one pair of right-hand twist grooves and at least one pair of left-hand twist grooves, the grooves of each said pair of right-hand twist grooves being located on opposite sides of said inner joint member longitudinal axis, the grooves of each said pair of left-hand twist grooves being located on opposite sides of said inner joint member longitudinal axis.

Referring to Figs. 1 and/or 3 of Aucktor et al. '453, it is clearly shown that on the inner joint member the grooves of each pair of right-hand twist grooves are not located on opposite sides of the inner joint member longitudinal axis. Nor are the grooves of each pair of left-hand twist grooves located on opposite sides of the inner joint member longitudinal axis. Rather, Aucktor et al. teach an inner joint member (and an outer joint member) having a pair of right and left-hand twist grooves, the grooves of the pair being located on opposite sides of its longitudinal axis. This is demonstrated below with reference to Figs. 1 and 3 of Aucktor et al. '453:



Independent Claim 10 calls for an inner joint member having a longitudinal axis centered with respect thereto and an outer surface defining a plurality of radially outwardly facing substantially helical grooves, wherein each said helical groove curves in the same rotational direction as a corresponding helical groove disposed on an opposite side of said longitudinal axis does, said plurality of radially outwardly facing substantially helical grooves including a pair of right-hand grooves and a pair of left-hand grooves.

Referring again to the above illustrations, Aucktor et al. teach an inner joint member in which each helical groove thereof curves in an opposite rotational direction as a corresponding inner joint member helical groove disposed on an opposite side of the longitudinal axis does.

Attorney Reference No: DP-309838
Application Serial No.: 10/730,309

Because Aucktor et al. '453 fails to identically disclose or describe the invention of independent Claim 1 (and thus of Claims 2, 4, 5, 8 and 22 that depend therefrom) or independent Claim 10 (and thus of Claim 21 that depends therefrom), the rejections of Claims 1, 2, 4, 5, 8, 10, 21 and 22 under § 102(b) over this reference is improper. Applicants respectfully request that these rejections be withdrawn.

Applicants further submit that modification of the placement or orientation of the grooves in the joint disclosed in Aucktor et al. '453 will destroy the intent, purpose and/or function of the invention disclosed thereby, and respectfully remind the Examiner that the general rule is that a § 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference is not proper and the *prima facie* case of obviousness cannot properly be made. In other words, where there is no technological motivation for engaging in the modification and instead a disincentive, the rejection is improper. In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Claims 1, 2, 4, 5 and 8-22 have been rejected under § 102(b) as being anticipated by DE 3818730. Applicants respectfully traverse these rejections, submit that the rejections are improper, and request that they be withdrawn.

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554 (Fed. Cir. 1983) (citing Soundscriber Corp. v. U.S., 360 F.2d 954, 960, 148 U.S.P.Q. 298, 301, adopted, 149 U.S.P.Q. 640 (Ct.Cl. 1966)). DE 3818730 does not disclose each element of any of Claims 1, 2, 4, 5 and 8-22.

As noted above, independent Claim 1 calls for an inner joint member having a longitudinal axis centered with respect thereto and an outer surface defining a plurality of radially outwardly facing substantially helical grooves including at least one pair of right-hand twist grooves and at least one pair of left-hand twist grooves, the grooves of each said pair of right-hand twist grooves being located on opposite sides of said inner joint member longitudinal axis, the grooves of each said pair of left-hand twist grooves being located on opposite sides of said inner joint member longitudinal axis.

Referring to Fig. 2 of DE 3818730 (shown below) it is clear that the reference teaches inner joint member helical grooves that are all of the same rotational direction (shown as being all left-hand twist). Fig. 4 of DE 3818730 (also shown below) alternatively shows that

on the inner joint member the grooves of each pair of right-hand twist grooves are not located on opposite sides of the inner joint member longitudinal axis. Nor are the grooves of each pair of left-hand twist grooves located on opposite sides of the inner joint member longitudinal axis. Rather, Fig. 4 of the reference teaches an inner joint member (and an outer joint member) having a pair of right and left-hand twist grooves, the grooves of the pair being located on opposite sides of its longitudinal axis.

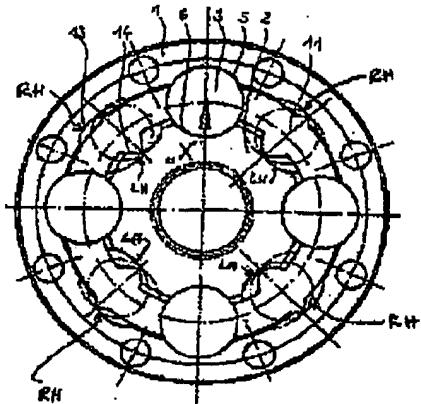


Fig. 2

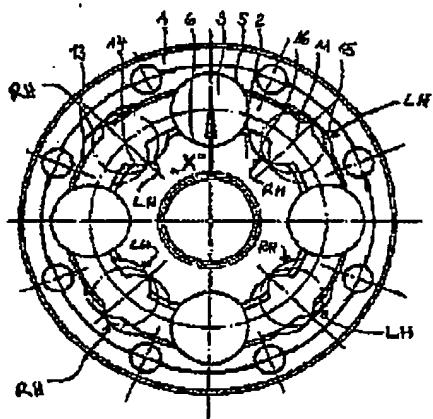


Fig. 4

As noted above, independent Claim 10 calls for an inner joint member having a longitudinal axis centered with respect thereto and an outer surface defining a plurality of radially outwardly facing substantially helical grooves, wherein each said helical groove curves in the same rotational direction as a corresponding helical groove disposed on an opposite side of said longitudinal axis does, said plurality of radially outwardly facing substantially helical grooves including a pair of right-hand grooves and a pair of left-hand grooves. Referring to Fig. 2 of DE 3818730, the reference teaches an inner joint member having a plurality of radially outwardly facing substantially helical grooves that does not include a pair of right-hand grooves. Rather Fig. 2 discloses two pairs of left-hand grooves. And referring to Fig. 4 of DE 3818730, the reference teaches an inner joint member in which each helical groove thereof curves in an opposite rotational direction as a corresponding inner joint member helical groove disposed on an opposite side of the longitudinal axis does.

Independent Claim 12 calls for an inner joint member having a longitudinal axis centered with respect thereto and an outer surface a plurality of radially outwardly facing grooves including four substantially helical grooves, two of the helical grooves extending in a right-hand rotational direction and disposed on opposite sides of the longitudinal axis, two of the helical grooves extending in a left-hand rotational direction and disposed on opposite sides of the longitudinal axis. As previously noted, Fig. 2 of DE 3818730 shows an inner joint member having a plurality of radially outwardly facing substantially helical grooves that does not include a pair of right-hand grooves. Rather Fig. 2 discloses two pairs of left-hand grooves.

As also previously noted, Fig. 4 of DE 3818730 shows that on the inner joint member the grooves of each pair of right-hand twist grooves are not located on opposite sides of the inner joint member longitudinal axis. Nor are the grooves of each pair of left-hand twist grooves located on opposite sides of the inner joint member longitudinal axis. Rather, Fig. 4 of the reference teaches an inner joint member (and an outer joint member) having a pair of right and left-hand twist grooves, the grooves of the pair being located on opposite sides of its longitudinal axis.

Because DE 3818730 fails to disclose each element of any of independent Claim 1 (and thus any of Claims 2, 4, 5, 8, 9, 16-20 and 22 depending therefrom), independent Claim 10 (and thus either of Claims 11 and 21 depending therefrom) and independent Claim 12 (and thus any of Claims 13-15 depending therefrom), the rejections of Claims 1, 2, 4, 5 and

8-22 under § 102(b) over this reference is improper. Applicants respectfully request that these rejections be withdrawn.

Applicants further submit that, as discussed above in connection with Aucktor et al. '453, under the holding of In re Gordon 733 F.2d 902, 221 U.S.P.Q. 1127 modification of the placement or orientation of the grooves in the joint disclosed in DE 3818730 will destroy the intent, purpose and/or function of the invention disclosed thereby, and again respectfully remind the Examiner that the general rule is that a § 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference is not proper and the *prima facie* case of obviousness cannot properly be made.

Claim Rejections under § 103(a):

Claims 9 and 11-20 have been rejected under § 103(a) as being obvious over Aucktor et al. '453 in view of US Pat. No. 5,685,777 (Schwarzler). At page 13, paragraph 3 of the Office Action, the Examiner refers to Claim 3, which was previously canceled. Applicants infer that the Examiner meant Claim 9 instead of Claim 3.

In rejecting Claims 9 and 16-20, which all depend from independent Claim 1 (which was not rejected under § 103(a)), the Examiner variously relies on the disclosure of Schwarzler '777 in no manner that properly renders independent Claim 1 obvious over any combination of Aucktor et al. '453 and Schwarzler '777. "Dependent claims are nonobvious under §§ 103 if the independent claims from which they depend are nonobvious." Hartness Int'l Inc. v. Simplimatic Eng'g Co., 819 F.2d 1100, 1108, 2 U.S.P.Q.2d 1826, 1831 (Fed. Cir. 1987). Therefore, no rejection of dependent Claims 9 and 16-20 under § 103 based on any combination of Aucktor et al. '453 and Schwarzler '777 can be proper under the holding of Hartness Int'l Inc., for no combination of these references renders independent Claim 1 obvious under the statute. As noted above, Applicants submit that modification of the placement or orientation of the grooves in the joint disclosed in Aucktor et al. '453 will destroy the intent, purpose and/or function of the invention disclosed thereby, and respectfully remind the Examiner that the general rule is that a § 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference is not proper and the *prima facie* case of obviousness cannot properly be made. In other words, where there is no technological motivation for engaging in the modification and instead a disincentive, the rejection is improper. In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Applicants submit there is no

technological motivation disclosed in the cited prior art for engaging in a modification of the joint of Aucktor et al. '453 that would yield the invention of independent claim 1.

For the above reasons, none of Claims 1 and its dependent claims may properly be rendered obvious under § 103 over Aucktor et al. '453 alone or in combination with any other reference of record.

Similarly, in rejecting Claim 11 which depends from independent claim 10 (which was not rejected under § 103(a)), the Examiner relies on the disclosure of Schwarzler '777 in a manner that does not properly render Claim 10 obvious over any combination of Aucktor et al. '453 and Schwarzler '777, for there is no technological motivation disclosed in the cited prior art for engaging in a modification of the joint of Aucktor et al. '453 to yield the invention of independent claim 10. Therefore, under Hartness Int'l, Inc. v. Simplimatic Eng'g Co., Id., no combination of these references properly renders dependent Claim 11 obvious under the statute. For the above-stated reasons, neither of Claims 10 and 11 may properly be rendered obvious under § 103 over Aucktor et al. '453 alone or in combination with any other reference of record.

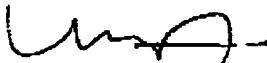
Applicants respectfully traverse the rejections of Claims 12-15 under § 103(a) over Aucktor et al. '453 in view of Schwarzler '777, and submit that no combination of these references may properly render independent Claim 12 (and thus dependent claims 13-15) obvious under the statute. As noted above, In re Gordon reiterates the general rule that a § 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference is not proper and the *prima facie* case of obviousness cannot properly be made. 733 F.2d 902, 221 U.S.P.Q. 1127. Applicants submit that modification of the placement or orientation of the grooves in the joint disclosed in Aucktor et al. '453 will destroy the intent, purpose and/or function of the invention disclosed thereby. Moreover, no teaching in Schwarzler '777 suggests modifying the groove orientation and placement taught by Aucktor et al. '453 to yield the invention of any of Claims 12-15.

For the above reasons Applicants respectfully requests that all rejections under §103(a) now be withdrawn.

Applicants submit that the present application is in condition for allowance, and respectfully request that all objections to and rejections of the claims now be withdrawn and that their allowance be granted.

Should there be any questions regarding this Amendment, the Examiner is respectfully invited to telephone the undersigned at (248) 813-1250. In the event that Applicants have overlooked the need for an extension of time, payment of fee, or payment of additional amount of fee, Applicants hereby petition therefor and authorize that any charges, or credit for any overpayment, be made to Deposit Account No. 50-0831, Delphi Technologies, Inc.

Respectfully submitted,



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July 13, 2006

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CERTIFICATE OF MAILING

The undersigned hereby certifies that this document is being deposited with the United States Postal Service in an envelope as first class mail addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

July 13, 2006.

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